UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,656	11/12/1999	NICHOLAS J. ELSEY	1631077-0028	4745

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EXAMINER
AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 03/25/2004   *25*

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _29 December 2003_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims   *26, 27 are cancelled.*

4) ☒ Claim(s) _22 – 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 - 97_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _22 – 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 - 97_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to applicant's amendment filed on 12/29/03. Claims 22

– 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 - 97 are now pending in the present

application. **This action is made final.**

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

2.   Claims 22 – 25, 28, 41 – 44, 46 - 50, 53,66 – 69, 71 – 75, 78 – 86, and 89 – 93

are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application

Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden) and

further in view of US Pat Pub 2002/0078004 (Ambrosini et al.), US 6,081,898 (Miller et

al.) and US 5,574,776 (Leuca et al.)

As to claims 22, 41, 47, and 66, Cox et al. teach a method and apparatus for

providing directory assistance wherein an initiator of the communication connection is

associated with various data elements as claimed, those elements being either ANI, area of the caller's origination, the caller's identity, etc. and is identified based on that data. Of course with data elements such as those noted, it is inherent that there must be a data source where such elements can be stored and accessed. Furthermore, depending on the type of service the caller desires, whether it be retrieval of a desired telephony number or the leaving of a message or the paging of an unreachable destination party, the caller's right to access or have that particular service performed is first verified. If the caller is verified and has the authority to make the desired call, receive/use the desired information, the appropriate actions are taken. (Page 1, paragraphs 0004 – 0005 and 0008, Page 2, paragraphs 0012 – 0016, Page 3, paragraphs 0036, Page 4, paragraph 0044 – Page 7, paragraph 0072)

Cox et al. has been discussed above but does not teach explicitly the editing and deletion of a directory or directory information, although Cox et al. does teach a caller/subscriber being able to provision certain preferences.

However, Darden teaches a personal electronic directory allowing or the creation, editing, deletion, and general manipulation of one's personal directory. Including such flexibility in the system of Cox et al. would be obvious to one skilled in the art inasmuch as Cox et al. already teach being able to access different types of directories and databases. Including a personal, editable directory would simply be extending the invention of Cox et al. to access just another type of directory and giving the caller/subscriber more authority. Again, because Cox et al. already teach making certain features of the system programmable/customizable to a specific

caller/subscriber, such would be obvious to one skilled in the art. Lastly, the trend of

telecommunications has always been and continues to be one which gives the personal

user/caller/subscriber more flexibility with their own services, to give them more control.

Such reasoning too would make it obvious to combine the teachings of Cox et al. and

Darden. (Abstract, Col. 2, lines 39 – Col. 3, line 50, Col. 5, line 8 – Col. 10, line 26 of

Darden)

Furthermore, as taught by Ambrosini et al. it is old and well known to allocate

various levels of access to directory services such as directory assistance wherein the

different levels of user access to information in directory assistance are defined in the

Bellcore F20 Specification (BR 754-110-103, Issue 8, September 1998, Rev. 1, March

1991). (P. 4, ¶ 0039 of Ambrosini et al.) Also allocating different levels of access to

directories can even be seen various computer arts wherein certain file directories or

folders are given different levels of access. As mentioned above, the data source is

inherent in such a system and would also be inherent in any system having different

levels of access. There must be some data source where users can be identitied as

having those different levels of access. Material that is not technically prior art can be

relied upon as evidence of the skill level in the art as of about the date of invention, e.g.,

a later dated publication, *Gould v. Quigg, 3 USPQ2d 1302 (Fed. Cir. 1987)*.

Furthermore, Cox et al. and Darden do not teach connecting an initiator to the

selected data element even if disclosure is prohibited.

However, such is a very old and common procedure. An example of this would

arise when calling the Director of the USPTO. A secretary who handles the incoming

telephone calls is used basically to screen calls and could decide to connect a person to the Director without giving that person the actual/direct telephone number of the Director. If one merely calls a corporation and asks for a telephone number of an employee, many times, the operator will not give out the telephone number but will agree to connect the person. This is done for many reasons. One is simply because, if the desired telephone number was given out, there would be no way to screen callers since they could call at anytime bypassing the operator or secretary. This is a common motivation and would have been an obvious feature to include in the invention of Cox et al. by one of ordinary skill in the art.

Cox et al. and Darden also do not teach the use of an intermediate agent that acts on behalf of the initiator, wherein that agent is accorded the level of access the initiator has.

However, such is at the least obvious in many directory assistance systems as can be seen in the above discussion regarding an example of what happens what one calls a business employee such as the Director of the USPTO. In this example, the secretary would be analogous to the claimed agent taking the action on behalf of the initiator. Of course, if an outside caller is the initiator, the secretary, as discussed above will connect the call, but not give out a direct number. If however, the Director himself called, asking for the telephone number of a USPTO employee, the secretary would be able to relay that number to him. As an employee, the Director would have more access to the employee directory than an outside caller.

Another example of an intermediate agent is taught by Miller et al. wherein a requesting party must demonstrate knowledge of a shared secret to gain access to directory service entries via a remote agent acting on behalf of the requesting party. (Col. 6, lines 66 – Col. 7, line 19 of Miller et al.) Of course, as discussed above, differing levels of access to directory systems is known and would be applied here as well. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have implemented such a feature in Cox et al. and Darden simply because security is a common motivation as is remote access to information services.

Another example, in a different circumstance, is taught by Leuca et al. In the realm of text telephone devices (TDD) and the hearing impaired, intermediate agents is an old and well known method of operation. Leuca et al. teaches that for a hearing impaired person to access a service such as directory assistance, a relay service, wherein the relay service is an unimpaired agent or operator that can act on behalf of the hearing impaired initiator. (Col. 1, lines 15 – 34 of Leuca et al.) Again, of course, as already discussed above, security and differing levels of access would also be obvious if not inherent in this situation as well. And again, it would have been obvious for one of ordinary skill in the art to have employed such functionality in the system of Cox et al. and Darden, inasmuch as in one sense, such functionality could be implemented as a front-end, merely controlling access, so that a hearing impaired person could access the directory assistance system of Cox et al.

Moreover, the levels of access will always be a function of the level of access of the initiator as discussed above, because the operator will always have ultimate access to the entire directory, whereas the initiator, depending on his/her access level will not.

As to claims 23 – 25 and 48 – 50, Cox et al. teach a directory assistance means and method wherein the information sought by the caller is information concerning an individual such as a telephone number or address or even groups such as information regarding/coming from business directories as opposed to private individuals. Moreover, inherent in Cox et al. or any other directory assistance system for that matter is reading the selected data element, otherwise there would be no other way to ascertain the data and present it to the caller or even simply to retrieve it, the data element must be read. And of course as already mentioned accessing a data source where those data elements are stored and accessed   (See above references to Cox et al.)

As to claims 28, 42 – 44, 46, 53, 67 – 69, and 71, of course the communications service would include a voice communications service as taught by Cox et al. The present invention as well as Cox et al. and most any other standard directory assistance means and method would have to include a communications service that included making a telephone connection. Simply getting access to the directory assistance system would entail having to use a voice communications system and having to make a telephone connection. Moreover, see Fig. 1 and Data servers 120a for example which are analogous to the claimed "database[s] includ[ing] a directory." As already discussed above, the invention of Cox et al. is a directory assistance system. As also

discussed above, Cox et al. teach verifying the authority of a caller to access certain desired information and/or to have hose calls completed by the directory assistance system. (See above references to Cox et al.)

As to claims 76, 77, 87, 88, and 94 – 97, see P. 6, ¶ 0064 of Cox wherein it is explicitly taught that either a live operator or voice server may be used.

3.   Claims 29 and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication US 2002/0085702 (Cox et al.) in view of US Pat 5,204,894 (Darden), US 6,081,898 (Miller et al.), US 5,574,776 (Leuca et al.) and further in view of US Pat 6,404,884 (Marwell et al.)

The cited prior art references have been discussed above, but do not discuss the initiator establishing an internet connection. However, telephony and the internet are well known to now be blended in this and many other types of art. Telephone calls can be made via the internet, call centers may be accessed using both a computer/internet and a standard POTS telephone. Inasmuch as this is the case, it would have been very obvious for one skilled in the art to have allowed access to the claimed present system via the internet. Many services operate this way presently as it just is another way of accessing the service and nothing more. Moreover, Marwell et al. teach accessing and manipulating a personal contact list, which is analogous to the above-discussed personal directory, via the web. (Abstract, Figs. 5 – 13, Col. 5, line 9 – 24 of Marwell et al.)

Also, the above-mentioned ANI data element is essentially a calling party's telephone number.

Response to Arguments

4.   Applicant's arguments with respect to claims 22 – 29, 41 – 44, 46 – 50, 53, 54, 66 – 69, 71 – 93 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
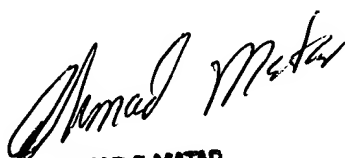
6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hector A. Agdeppa whose telephone number is 703-

305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

        Information regarding the status of an application may be obtained from the

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H.A.A.
March 19, 2004

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